UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,104	02/27/2004	Jared Ross Van Orman	JV03-01	7677

7590 02/06/2008

Angus C. Fox, III
4093 N. Imperial Way
Provo, UT 84604-5386

EXAMINER	
OMGBA, ESSAMA	

ART UNIT	PAPER NUMBER
3726	

MAIL DATE	DELIVERY MODE
02/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/789,104	VAN ORMAN ET AL.	CT
	Examiner	Art Unit	
	Essama Omgba	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-14 and 21-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-14 and 21-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 8, 9, 11-14 and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art (AAPA).

Applicant, at pages 1-3 and specifically at pages 5 and 6 of the specification where a discussion of figures 1-4 (labeled as prior art) is carried out, discloses a method of manufacturing a bracelet, comprising the steps of: cutting a laminar metal strip **101** to a desired length and width, the laminar metal strip **101** having first and second parallel, opposed, generally planar major surfaces, coating at least the first major surface with a metal marking layer **201**, subjecting the coated piece of sheet metal **101** to a raster scanning laser beam (figure 3), whereby heat generated by the laser beam causes selected regions of the metal marking layer **201** to form at least one ceramic design **301** that is adhered to at least the first major surface, removing all portions **302** of the marking layer that has not been treated by the laser beam and adhered to the first major surface, bending the metal strip **101** to form a bracelet having a general C-shaped side profile, and wherein the first and second major planar surfaces are transformed to curvilinear surfaces. Although it is not shown, it is inherent that the flat strip **101** is bent

because bracelets have a curved shape. The specific materials of the marking layer claimed can be found on page 6, first full paragraph of Applicant's specification.

3. Claim 10 is rejected under 35 U.S.C. 102(a) as being anticipated by AAPA or, in the alternative, is rejected under 35 U.S.C. 103(a) as obvious over AAPA.

It is inherent that a table is used under the metal strip shown in figure 3 during laser emission. Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided a positioning table, in order to support the metal strip during laser processing.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Robertson (US Patent 5,855,969).

AAPA discloses the invention cited above with the exception of specifically disclosing that the laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface.

Robertson teaches a computer controlled **30** raster-scanning infrared energy emitting carbon dioxide laser system that scans in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface (see entire abstract).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA with a laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface, in light of the teachings of Robertson, in order to provide an accurate and automated laser marking system.

AAPA does not specifically disclose that the marking layer comprises titanium dioxide.

Robertson teaches using titanium dioxide (col. 5, line 52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA with titanium dioxide in the marking layer, in light of the teachings of Robertson, in order to provide a material that effectively creates a marking when subjected to lasers.

6. Claims 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA.

AAPA discloses a method of manufacturing a bracelet as shown above. AAPA does not specifically disclose coating both sides of the metal strip. However, Official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have coated both sides of a metal strip in order to create a bracelet that has a consistent design and color. Furthermore, the particular thickness of the coating is considered an obvious matter of design choice to a person of ordinary skill in the art, at the time of the invention, depending upon the desired coating material that is

used. In addition, official notice is taken that the use of the claimed thicknesses are well known to a person of ordinary skill in the art.

7. Claims 25, 27 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Barr (US patent 5,586,390).

AAPA discloses a method of manufacturing a bracelet as shown above. AAPA does not specifically disclose rounding any square corners.

Barr teaches rounding any square corners to form rounded ones **36, 35**.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA with rounding any square corners, in light of the teachings of Barr, in order to provide a desired bracelet design. AAPA does not specifically disclose coating both sides of the metal strip. However, Official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have coated both sides of a metal strip in order to create a bracelet that has a consistent design and color.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Shapiro (US Patent 1,634,562).

AAPA discloses a method of manufacturing a bracelet as shown above. AAPA does not specifically disclose using rollers to bend the strip.

Shapiro teaches that it is known to use rollers **45, 46** to bend (figure 11).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided rollers to bend the metal strip, in order to create a symmetrically shaped jewelry article.

9. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Barr as applied to claim 27 above, and further in view of Robertson.

AAPA/Barr discloses the invention cited above with the exception of specifically disclosing that the laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface.

Robertson teaches a computer controlled **30** raster-scanning infrared energy emitting carbon dioxide laser system that scans in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface (see entire abstract).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA/Barr with a laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface, in light of the teachings of Robertson, in order to provide an accurate and automated laser marking system.

It is inherent that a table is used under the metal strip shown in figure 3 of AAPA during laser emission. Alternatively, Official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided a positioning table, in order to support the metal strip during laser processing.

10. Claims 8-14, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Tizzi (US Patent 3,955,934) *(If Applicant amends the claims to recite a specific sequence for the steps or if Applicant argues that the claims recite a specific sequence of the recited steps).*

With regards to claims 8, 11-14 and 23, AAPA teaches in figures 1-4 of Applicant's specification, a method of manufacturing a bracelet, comprising the steps of: cutting a laminar metal strip **101** to a desired length and width, the laminar metal strip **101** having first and second parallel, opposed, generally planar major surfaces, coating at least the first major surface with a metal marking layer **201**, subjecting the coated piece of sheet metal **101** to a raster scanning laser beam (figure 3), whereby heat generated by the laser beam causes selected regions of the metal marking layer **201** to form at least one ceramic design **301** that is adhered to at least the first major surface, removing all portions **302** of the marking layer that has not been treated by the laser beam and adhered to the first major surface, bending the metal strip **101** to form a bracelet having a general C-shaped side profile, and wherein the first and second major planar surfaces are transformed to curvilinear surfaces. Although AAPA does not specifically disclose the bending taking place after the marking step, however it is known to form a jewelry article by first marking a substrate with ornamental design and subsequently forming the jewelry article by bending the marked substrate as attested by Tizzi, see column 2, lines 18-38 and column 4, lines 59-66. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have bend the laminar strip of AAPA after laser marking, in light of the teachings of Tizzi, as is known in the art. Applicant should note that the specific materials of the marking layer claimed can be found on page 6, first full paragraph of Applicant's specification.

For claims 21 and 24, AAPA/Tizzi does not specifically disclose coating both sides of the metal strip. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have coated both sides of a metal strip in order to create a bracelet that has a consistent design and color. Furthermore, the particular thickness of the coating is considered an obvious matter of design choice to a person of ordinary skill in the art, at the time of the invention, depending upon the desired coating material that is used. In addition, official notice is taken that the use of the claimed thicknesses are well known to a person of ordinary skill in the art.

11. Claims 9, 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Tizzi as applied to claim 8 above, and further in view of Robertson.

For claims 9 and 22, AAPA/Tizzi discloses the invention cited above with the exception of specifically disclosing that the laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface.

Robertson teaches a computer controlled **30** raster-scanning infrared energy emitting carbon dioxide laser system that scans in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface (see entire abstract).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA/Tizzi with a laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface, in light of the teachings of Robertson, in order to provide an accurate and automated laser marking system.

AAPA/Tizzi discloses a method of manufacturing a bracelet as shown above. AAPA/Tizzi does not specifically disclose that the marking layer comprises titanium dioxide.

Robertson teaches using titanium dioxide (col. 5, line 52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA/Tizzi with titanium dioxide in the marking layer, in light of the teachings of Robertson, in order to provide a material that effectively creates a marking when subjected to lasers.

For claim 10, it is inherent that a table is used under the metal strip shown in figure 3 during laser emission. Alternatively, the examiner submits that it is within the general knowledge of a person of ordinary skill in the art, at the time of the invention, to have provided a positioning table, in order to support the metal strip during laser processing.

12. Claims 25, 27 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Tizzi as applied to claim 8 above, and further in view of Barr.

AAPA/Tizzi discloses a method of manufacturing a bracelet as shown above. AAPA/Tizzi does not specifically disclose rounding any square corners.
Barr teaches rounding any square corners to form rounded ones **36, 35**.
Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA/Tizzi with rounding any square corners, in light of the teachings of Barr, in order to provide a desired bracelet design.
AAPA/Tizzi does not specifically disclose coating both sides of the metal strip. However,

official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have coated both sides of a metal strip in order to create a bracelet that has a consistent design and color.

13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Tizzi as applied to claim 8 above, and further in view of Shapiro.

AAPA/Tizzi discloses a method of manufacturing a bracelet as shown above. AAPA/Tizzi does not specifically disclose using rollers to bend the strip. Shapiro teaches that it is known to use rollers **45, 46** to bend (figure 11). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided rollers to bend the metal strip, in order to create a symmetrically shaped jewelry article.

14. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Tizzi/Barr as applied to claim 27 above, and further in view of Robertson.

AAPA/Tizzi/Barr discloses the invention cited above with the exception of specifically disclosing that the laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface.

Robertson teaches a computer controlled **30** raster-scanning infrared energy emitting carbon dioxide laser system that scans in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface (see entire abstract).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of AAPA/Tizzi/Barr with a laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy

on a planer major surface, in light of the teachings of Robertson, in order to provide an accurate and automated laser marking system.

It is inherent that a table is used under the metal strip shown in figure 3 of AAPA during laser emission. Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided a positioning table, in order to support the metal strip during laser processing.

Response to Arguments

15. Applicant's arguments filed May 14, 2007 in response to the Office action mailed February 5, 2007, and November 13, 2007 in response to the Office action mailed August 9, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that AAPA does not show the ordered steps of cutting, laser marking and bending a piece of sheet metal, the examiner submits that the claims do not set forth any ordered steps. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments filed November 13, 2007 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The examiner as shown, as outlined in the above rejections, that it is known to form a jewelry article by first marking a

substrate with ornamental design and subsequently forming the jewelry article by bending the marked substrate.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Essama Omgba
Primary Examiner
Art Unit 3726

eo
January 28, 2008